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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Applicant | Magnesita Refractories Company |
| Applied for Mark | MAGNESITA |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Application Serial No.: | 85834316 |
| Application Filing Date: | January 28, 2013 |
| Mark: | MAGNESITA |
| Owner/Applicant/Appellant: | Magnesita Refractories Company |
| Attorney's Reference: | MAGN6029/TJM |

APPLICANT'S BRIEF

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September 21, 2015

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I. DESCRIPTION OF THE RECORD

The record is described by the Trademark Status and Document Retrieval ("TSDR") of the U.S. Patent and Trademark Office ("Office") as follows:

| <u>Date</u> | <u>Item</u> |
|---------------|---|
| Jul. 13, 2015 | ACTION DENYING REQ FOR RECON E-MAILED |
| May 07, 2015 | EX PARTE APPEAL-INSTITUTED |
| May 06, 2015 | TEAS REQUEST FOR RECONSIDERATION RECEIVED |
| Nov. 10, 2014 | SUBSEQUENT FINAL EMAILED |
| Sep. 23, 2014 | TEAS RESPONSE TO OFFICE ACTION RECEIVED |
| Mar. 26, 2014 | NON-FINAL ACTION E-MAILED |
| Mar. 06, 2014 | TEAS REQUEST FOR RECONSIDERATION RECEIVED |
| Sep. 09, 2013 | FINAL REFUSAL E-MAILED |
| Aug. 14, 2013 | TEAS RESPONSE TO OFFICE ACTION RECEIVED |
| Feb. 27, 2013 | NON-FINAL ACTION E-MAILED |
| Jan. 31, 2013 | NEW APPLICATION ENTERED IN TRAM |

II. STATEMENT OF THE ISSUE

Whether the final Office Action dated November 10, 2014, is correct in asserting that the present mark MAGNESITA (word without design or stylization) is generic and, alternatively, the mark is highly descriptive and has not acquired distinctiveness under Section 2(f) with respect to the goods and services:

Class 19: refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes;
and

Class 37: providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations.

III. RECITATION OF THE FACTS

Applicant filed the pending application under Section 1(a) of the Trademark Act on January 31, 2013. In the first Office Action dated February 27, 2013, the Examining Attorney refused the registration of “MAGNESITA” under Section 2(e)(1) allegedly on the basis that the applied-for mark merely describes the primary component of the Applicant’s goods. The Examining Attorney alleged that since the word magnesita translates to magnesite or magnesia and magnesite or magnesia is used in refractory products, the term “MAGNESITA” describes an important component of the Applicant’s goods and refused its registration. In its Response dated August 14, 2013, Applicant argued that the mark is suggestive, not merely descriptive.

In a final Office Action dated September 9, 2013, the Examining Attorney alleged that the mark was merely descriptive when used in connection with the goods and services named in the application. In its Request for Reconsideration dated March 6, 2014, Applicant asserted that the mark has acquired distinctiveness under Section 2(f) of the Lanham Act to overcome the allegation that the mark is merely descriptive of the goods and services. Applicant submitted a Declaration that the mark had been in substantially exclusive and continuous use in commerce since at least as early as October 1, 2010, by Applicant.

On March 26, 2014, the Examining Attorney issued a non-final Office Action alleging that the evidence of record was not sufficient to show acquired distinctiveness because Applicant’s mark was of a highly descriptive nature. The Examining Attorney further alleged that since the term “MAGNESITA” is Portuguese and is translated as magnesite, where magnesite, magnesia, or magnesium is the primary

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component of refractory products, the evidence of record was insufficient to show acquired distinctiveness of the mark. The Examining Attorney relied on excerpts from Hawley's Condensed Chemical Dictionary, Concise Encyclopedia of Chemical Technology, Materials Handbook, Dictionary of Materials Science, Concise Encyclopedia of Chemistry, and Scientific Encyclopedia to show that magnesite (MgCO_3) and magnesium oxide (MgO) can be used for refractories.

In its Response dated September 23, 2014, Applicant submitted a Declaration of Gross Sales from 2010 to 2013 to show that the gross sales of refractory products under the trademark MAGNESITA.

On November 10, 2014, the Examining Attorney issued a final Office Action which alleged that the previously submitted evidence was insufficient to support a claim of Section 2(f), since the proposed mark is considered generic with respect to applicant's goods in Class 19 and services in Class 37. The Examining Attorney alleged that the English translation of MAGNESITA is "magnesite" or "magnesia," which the Examining Attorney considered to be one of the primary components in refractory products. The Examining Attorney also asserted that even if the mark were not considered generic for the goods, the mark was certainly highly descriptive of the goods and services.

On May 6, 2015, Applicant filed a Request for Reconsideration, and submitted additional evidence of acquired distinctiveness: a Declaration of Gross Sales in 2014, in excess of US\$220,000,000; and a Declaration about Exclusive Use to show that "MAGNESITA" is not used by others. Applicant also amended the date of first use to October, 2008, with supporting documentation.

Applicant filed on May 7, 2015, a Notice of Appeal to the Trademark Trial and Appeal Board, with a request for remand that was granted. The Examining Attorney on July 13, 2015, issued a Request for Reconsideration Denied, which alleged that Applicant had not resolved all the outstanding issues, and not raised a new issue or provided any new or compelling evidence. This appeal was resumed on July 22, 2015.

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The Declaration About Exclusive Use filed on May 6, 2015, states as follows:

1. All statements made herein of my own knowledge are true, and all statements made on information and belief are believed to be true.
2. I have conducted searches on the Internet for web pages that offer refractory products for sale in the United States.
3. The attached exhibits are based on these searches, and accurately reflect the web page at the address at the top, and at the date and time shown at the lower right of each exhibit.
4. The attached Exhibit A shows at least the top of a web page at the alliedmineral.com website. Allied Mineral Products appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "castable refractories," and "precast refractory shapes." I did not observe any use of the term "magnesita" at this website.
5. The attached Exhibit B shows an image of a search for "magnesita" at the alliedmineral.com website.
6. The attached Exhibit C shows at least the top of a web page at the zircoa.com website. Zircoa appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "refractory brick." I did not observe any use of the term "magnesita" at this website.
7. The attached Exhibit D shows at least the top of a web page at the bnzmaterials.com website. BNZ Materials, Inc. appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "insulating firebrick." I did not observe any use of the term "magnesita" at this website.
8. The attached Exhibit E shows at least the top of a web page at the ssfbs.com website. Smith-Sharpe Fire Brick Supply appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "fire brick." I did not observe any use of the term "magnesita" at this website.

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9. The attached Exhibit F shows at least the top of a web page at the alsey.com website. Alsey refractories co. appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "firebrick," "mortar" and "castable." I did not observe any use of the term "magnesita" at this website.
10. The attached Exhibit G shows at least the top of a web page at the heatstoprefractormortar.com website. Heat Stop appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "refractory mortar" and "firebrick." I did not observe any use of the term "magnesita" at this website.
11. The attached Exhibit H shows at least the top of a web page at the axner.com website. Axner appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "refractory brick" and "firebrick." I did not observe any use of the term "magnesita" at this website.
12. The attached Exhibit I shows at least the top of a web page at the firebrickengineers.com website. Fire Brick Engineers Company appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "refractory products" and "fire brick." I did not observe any use of the term "magnesita" at this website.
13. The attached Exhibit J shows at least the top of a web page at the morganthermalceramics.com website. Morgan Advanced Materials appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "fire brick," and "firebrick." I did not observe any use of the term "magnesita" at this website.
14. The attached Exhibit K shows an image of a search for "magnesita" at the morganthermalceramics.com website.
15. The attached Exhibit L shows at least the top of a web page at the ortonceramic.com website. Orton to market testing of refractory products. I reviewed at least a portion of the website and observed use

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of the generic terms “refractory shapes,” “refractory brick” and “refractory materials.” I did not observe any use of the term “magnesita” at this website.

16. The attached Exhibit M shows at least the top of a web page at the tflhouston.com website. TFL Incorporated appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “firebrick,” and “refractories.” I did not observe any use of the term “magnesita” at this website.
17. The attached Exhibit N shows an image of a search for “magnesita” at the tflhouston.com website.
18. The attached Exhibit O shows at least the top of a web page at the hitempincusa.com website. Hi Temp Refractories to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “firebrick,” and “castables.” I did not observe any use of the term “magnesita” at this website.
19. The attached Exhibit P shows at least the top of a web page at the louisvillefirebrick.com website. Louisville Firebrick appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “firebrick,” and “refractory brick.” I did not observe any use of the term “magnesita” at this website.
20. The attached Exhibit Q shows at least the top of a web page at the kandg.net website. K&G Industrial Services appears to market the installation of refractory products. I reviewed at least a portion of the website and observed use of the generic term “refractory brick.” I did not observe any use of the term “magnesita” at this website.
21. The attached Exhibit R shows at least the top of a web page at the firebricks.com website. Firebricks appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “refractory bricks.” I did not observe any use of the term “magnesita” at this website.

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22. The attached Exhibit S shows at least the top of a web page at the elginbutler.com website. Elgin Butler appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.
23. The attached Exhibit T shows at least the top of a web page at the larkinrefractory.com website. Larkin Refractory Solutions appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.
24. The attached Exhibit U shows at least the top of the Terminology page at the larkinrefractory.com website. I observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.
25. The attached Exhibit V shows at least the top of a web page at the vitcas.com website. Vitcas appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “fire brick,” and “firebrick.” I did not observe any use of the term “magnesita” at this website.
26. The attached Exhibit W shows an image of a search for “magnesita” at the vitcas.com website.
27. The attached Exhibit X shows at least the top of a web page at the nockrefractories.com website. The Nock Refractories Company appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.
28. The attached Exhibit Y shows at least the top of a web page at the nwironworks.com website. The Northwest Iron Works appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.

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29. The attached Exhibit Z shows at least the top of a web page at the miamistoneinstallers.com website.

Miami Stone Installers.com appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "firebrick" and "fire brick." I did not observe any use of the term "magnesita" at this website.

30. The attached Exhibit AA shows at least the top of a page at the lowes.com website. Lowe's appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "firebrick." I did not observe any use of the term "magnesita" at this website.

31. The attached Exhibit AB shows at least the top of a page at the homedepot.com website. The Home Depot appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "fire bricks." I did not observe any use of the term "magnesita" at this website.

32. The attached Exhibit AC shows at least the top of a page at the walmart.com website. Walmart appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "fire brick" and "firebrick." I did not observe any use of the term "magnesita" at this website.

33. The attached Exhibit AD shows an image of a search for "magnesita" at the walmart.com website.

34. The attached Exhibit AE shows at least the top of a page at the amazon.com website. Amazon appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "fire brick" and "firebrick." I did not observe any use of the term "magnesita" at this website.

35. The attached Exhibit AF shows at least the top of a page at the rescoproducts.com website. RESCO Products, Inc. appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.

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36. The attached Exhibit AG shows at least the top of a page at the vesuvius.com website. Vesuvius appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.
37. The attached Exhibit AH shows at least the top of a page at the rhi-ag.com website. RHI appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.
38. The attached Exhibit AI shows at least the top of a page at the hwr.com website. ANH Refractories appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.
39. The attached Exhibit AJ shows at least the top of a page at the mineralstech.com website. Minerals Technology to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.

The Declaration of Gross Sales filed September 23, 2014, states as follows:

The gross sales of refractory products under the trademark MAGNESITA from May 1 to December 31, 2010 were in excess of US \$103,000,000 for domestic production.

The gross sales of refractory products under the trademark MAGNESITA from January 1 to December 31, 2011 were in excess of US \$200,000,000 for domestic production.

The gross sales of refractory products under the trademark MAGNESITA from January 1 to December 31, 2012 were in excess of US \$200,000,000 for domestic production.

The gross sales of refractory products under the trademark MAGNESITA from January 1 to December 31, 2013 were in excess of US \$230,000,000 for domestic production.

The Declaration of Gross Sales in 2014, filed May 6, 2015, states that the gross sales of refractory products associated with the trademark MAGNESITA from January 1 to December 31, 2014 were in excess of US \$220,000,000 for domestic production.

IV. ARGUMENT

A. THE STANDARD OF REVIEW.

Applicant respectfully submits that the standard of review should be reconsidered in view of the Supreme Court's decision in the case *B & B Hardware, Inc. v. Hargis Industries, Inc.*, ___ U.S. ___, 135 S.Ct. 1293 (2015) (Ultimately, Board decisions on likelihood of confusion ... should be given preclusive effect on a case-by-case basis)." 135 S.Ct. at 1306. This subjects the present Applicant to the risk that a court may later give a Board decision preclusive effect. See also, *Vicor Corporation v. Synqor, Inc.*, 2015 WL 2172160 (Patent Tr. & App. Bd.) ("agency decision is grounds for issue preclusion in litigation" citing *B & B Hardware*).

The Supreme Court held that the "Eighth Circuit likewise erred by concluding that Hargis bore the burden of persuasion before the TTAB. B & B, the party opposing registration, bore the burden," 135 S.Ct. at 1309. The Court has instructed that burden of persuasion should be on the party opposing registration, which in the present appeal is the Examining Attorney.

Applicant acknowledges the Federal Circuit precedence arguably to the contrary. In *ex parte* cases, the question is simply "whether or not, based on the record before the examiner, the examiner's action was correct." *In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1 (Fed. Cir. 1985).

Moreover, it would be arbitrary and capricious, and an abuse of discretion, to continue different standards of review for *ex parte* trademark appeals versus *ex parte* patent appeals. *Compare, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) ("The PTO has the burden under section 103 to establish a *prima facie* case of obviousness [citation omitted]." 837 F.2d at 1074).

**B. THE EXAMINING ATTORNEY HAS NOT ESTABLISHED CLEAR EVIDENCE TO
SHOW GENERICNESS OF THE MARK.**

The present refusal is based in part on the statutory provision that requires the mark to be “capable of distinguishing the applicant’s goods and services.” 15 U.S.C. §1091(c) (2005). Generic terms are “incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.” (TMEP § 1209.01(c)).

In proving genericness, the Office has the difficult burden of proving the refusal with “clear evidence” of genericness. *In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 2 (TTAB 2006) (non-precedential) (citing *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)); see also *In re Steelbuilding.com*, 415 F.3d 1293, 1296, 75 USPQ2d 1420 (Fed. Cir. 2005). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528 (Fed. Cir. 1986)). Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, whether the term sought to be registered or retained on the register is understood by the relevant public primarily to refer to that genus of goods or services. *H. Marvin Ginn Corp.*, 782 F.2d 990. Doubt on the issue of genericness is resolved in favor of the applicant. *In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3 (citing *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993)). In this case, Applicant submits that the Examiner has failed to establish by clear evidence that the mark “MAGNESITA” is understood by the relevant public to be generic by primarily referring to the class of goods and services at issue, i.e., refractory products and information services.

**1. THE CATEGORY OF THE GOODS AND SERVICES AT ISSUE IS
REFRACTORY PRODUCTS AND INFORMATION SERVICES.**

In determining the first step of genericness, Applicant submits that the category of goods and services at issue is refractory products and information services. Specifically, the goods are “refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes,” while the services are “providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations.”

**2. THE RELEVANT PUBLIC WOULD NOT UNDERSTAND THE WORD
“MAGNESITA” TO PRIMARILY REFER TO REFRACTORY PRODUCTS
AND INFORMATION SERVICES.**

The Examining Attorney has failed to properly identify the relevant public and provide clear evidence that the relevant public *primarily* refers to refractory products and information services by the present mark. In determining the second step of the genericness determination, the court must identify the relevant public by identifying who actually or potentially purchases or consumes the goods, and whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. *See H. Marvin Ginn Corp.*, 782 F.2d at 989; *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641, 19 USPQ2d 1552 (Fed. Cir. 1991); *see also* TMEP § 1209.01(c). In this case, the Examining Attorney has not established that the relevant public would have understood the mark “MAGNESITA” as primarily referring to refractory products or information services.

Although the Examining Attorney alleged in the Final Action of November 10, 2014 and Denial of the Request for Reconsideration of July 13, 2015 that the proposed mark “MAGNESITA” is generic,

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the Examining Attorney has not provided clear evidence to support this conclusion. The Examining Attorney has not identified the relevant public. Applicant submits that since the relevant public for a genericness determination is the *actual or potential purchaser* of the goods or services, the relevant public in this case is any actual or potential purchaser of refractory products or information services, which in this case is the general public. *See Magic Wand, Inc.*, 940 F.2d at 641. In so doing, as is clear from the plain reading of the identification of goods in Class 19 and services in Class 37, the refractory products and information services are not limited to a particular group of customers, but to any *actual or potential purchaser*. In other words, since any doubt on the issue of genericness is resolved in favor of the applicant, the relevant public in this genericness determination is the general public, because the general public actually or potentially purchases the refractory products and information services. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3.

The Examining Attorney erroneously asserts that since magnesia and magnesite may be used in the goods and services, the ingredient may be generic for the goods and services. Applicant submits that the test for genericness is not whether any ingredient may be generic for those goods and services, but rather, whether the relevant public would *primarily* use or understand the term sought to be protected to refer to the genus of goods and services in question. *See H. Marvin Ginn Corp.*, 782 F.2d at 991.

For example, this Board in *In re Tires, Tires, Tires, Inc.* held that the term “tires” was generic because the term “tires” identifies a key aspect of applicant’s services, i.e., the goods sold in applicant’s retail store, and the recitation of services specifically uses the term “tires” to name the subject matter of applicant’s retail services. *In re Tires, Tires, Tires, Inc.*, 94 U.S.P.Q.2d 1153, 2009 WL 4075360 * 5 (TTAB 2009). Similarly, the Court of Appeals for the Federal Circuit held that the word “BUNDT” for “ring cake mix” was generic since BUNDT was the common descriptive name of the type of cake being sold. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 1560 (Fed. Cir. 1985).

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In contrast, in the present appeal, the Examining Attorney has not provided record evidence to suggest that the term “MAGNESITA” *primarily refers* to the class of refractory products and information services. Rather, as evidenced by Exhibits A to AJ filed with the Request for Reconsideration of May 6, 2015, the relevant public would have understood that the terms “castable refractories,” “precast refractory shapes,” “mortar,” “castable,” “fire brick,” and “refractory brick” are used as the generic terms for various refractory products and information services (Dec. ¶ 4-39).

The Examining Attorney cited a third party website excerpt about Applicant. “The Company benefits from some of the largest and highest quality reserves of dolomite, magnesite, and talc in the world. Magnesita also has other mineral deposits, including chromite and several clays through Brazil. The Company is able to use 80% (by volume) of its own raw materials in the production of refractories.” See page 3 of the Final Office Action in the TSDR dated November 10, 2014. Further, the types of products Applicant produces include: 1) Bricks and Shapes of: Alumina, Alumina Mag Carbon/Mag, Alumina Carbon, Alumina Silicon Carbide, Bottom Pour, Doloma/Magnesia Doloma- fired and cured, Magnesita Carbon, Magnesita Chrome, Magnesita Spinel, and Pre-cast and –basic and alumina and 2) Bulk Refractories of: Castables – basic and alumina, Coatings, Dry Vibratables, Gunning Mixes, Mortars, Plastics, Ramming Mix, and Taphole Mix (at page 4 of the Final Office Action in the TSDR dated November 10, 2014). This excerpt does not support the Examining Attorney’s allegation that MAGNESITA is generic.

The Examining Attorney has failed to provide clear evidence that the relevant public would have understood the term “MAGNESITA” to be generic and to *primarily refer* to refractory products and information services.

In fact, the Examining Attorney has not provided any evidence that the relevant public uses the term “MAGNESITA” to refer to any refractory product or information service. *See In re Minnetonka, Inc.*, 3 USPQ2d 1711, 1987 WL 124303 * 3 (TTAB 1987) (“This body of evidence is persuasive, and the

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Examining Attorney does not claim otherwise, to show that there exists a fairly substantial number of competitors in the business of selling liquid hand soap; that none of these competitors uses the term ‘soft soap’ descriptively, generically or otherwise in connection with its product.”) At most, the Examining Attorney has established magnesite can be used as a component of the goods sold on various websites, e.g. refractory brick, lining, etc., and has also established that other materials can be used for such refractory products. For example, as seen in the printed web-page for Vitcas provided by the Examining Attorney on July 13, 2015, the refractory mortars are high alumina refractories, e.g., 44-88% Al_2O_3 with varying concentrations of iron oxide, Fe_2O_3 (at pages 4-6 of the Request for Reconsideration Denied in the TSDR). Similarly, as seen in the printed web-page for Zircoa, the refractory backup primarily includes custom granular Zirconium Oxide in unstabilized (pure) form or stabilized (combined) with yttrium oxide, magnesium oxide, or calcium oxide for structural stability (at page 11 of the Request for Reconsideration Denied in the TSDR). What the Examining Attorney has failed to establish by clear evidence, however, is that the relevant public uses the terms magnesite or magnesite or “MAGNESITA” to *primarily refer* to the class of refractory products or information services.

In other words, Applicant submits that unlike this Board’s holding in *In re Tires, Tires, Tires, Inc.* and the Federal Circuit’s holding in *In re Northland Aluminum Products, Inc.*, where the proposed marks were found to be generic since the marks primarily referred to the genus of the class for the applicant’s goods and services, the present mark MAGNESITA does not refer to the genus of “refractory products and information services.” The Examining Attorney has not established by clear evidence that the relevant public would have understood that the term “MAGNESITA” *primarily refers* to the class of goods and services for refractory products and information services.

The present goods and services are not magnesite or magnesite, where magnesite has the chemical formula MgCO_3 and is used to produce magnesite having the chemical formula MgO . Rather, the present goods are “refractory products not made primarily of metal” and services for “providing

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information via a global computer network on the use of refractory products.” Magnesite is a compound in Class 1 and not in Class 19 or 37. In other words, while magnesia and magnesite are generic terms to identify different minerals, the Examining Attorney has not provided clear evidence to establish that magnesia and magnesite are generic terms to *primarily* identify refractory products or information services. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 *3 (“The two references to “Oat Straw” hair care preparations which appear to be generic in nature do not constitute a clear or substantial showing of generic use.”)

The Examining Attorney has failed to establish by clear evidence that the relevant public uses the term “MAGNESITA” to *primarily refer* to refractory products or information services and only has established that magnesia and magnesite can be used as one component of refractory brick or lining, which can also include alumina, zirconium, silica, yttrium, calcium, etc. as primary ingredients. Thus, this Board must conclude that “MAGNESITA” is not generic for the Applicant’s refractory products of Class 19 or information services of Class 37.

C. THE MARK “MAGNESITA” HAS ACQUIRED DISTINCTIVENESS

The statute allows the registration of “a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. §1052(f) (2005). The “Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” 15 U.S.C. § 1052(f).

The amount and character of such evidence depends on the facts of each case, however, necessarily varies, depending upon the degree of descriptiveness involved, and becomes progressively greater as the descriptiveness of the term increases. *In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694 * 3 (TTAB 2002) (non-precedential) (*citing Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001,

1008 (Fed. Cir. 1988)); *In re Whitetail Inst. Of North America, Inc.*, 2014 WL 1390517 * 2 (TTAB 2014) (non-precedential). “To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 U.S.P.Q.2d 1420, 1422 (Fed. Cir. 2005).

1. THE MARK “MAGNESITA” IS NOT HIGHLY DESCRIPTIVE.

In determining whether a mark is highly descriptive, the Board should initially determine whether the Examining Attorney has submitted evidence to establish that the mark immediately tells prospective customers about the features of applicant’s goods or services, and then whether the record has a sufficient number of references to establish that the mark is highly descriptive. *See In re Greek Gourmet, Inc.*, 2000 WL 1720159 * 2 (TTAB 2000) (non-precedential); *see also In re the Kyjen Company, Inc.*, 2012 WL 1424429 * 6 (TTAB 2012) (non-precedential), *In re Whitetail Inst. Of North America, Inc.*, 2014 WL 1390517 * 3 (TTAB 2014).

The Examining Attorney has not provided the necessary evidence to establish that the mark “MAGNESITA” is highly descriptive of Applicant’s goods and services. Although the Examining Attorney has provided evidence that magnesia or magnesite can be used in refractory products, the Examining Attorney has not provided evidence that the mark “MAGNESITA” is highly descriptive of “refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes,” and “providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations.”

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Specifically, the Examining Attorney has not provided the necessary evidence to establish that the mark "MAGNESITA" immediately tells prospective customers about the features of Applicant's goods or services. Rather, the Examining Attorney only provides evidence that the English translation of "MAGNESITA" is "magnesite" or "magnesia." While the Examining Attorney has not cited a case where the doctrine of foreign equivalents has been applied in the context of an assertion of acquired distinctiveness, Applicant submits that even assuming, but not admitting that "MAGNESITA" would be understood by a significant portion of the relevant potential purchasers to mean "magnesite" or "magnesia," the Examining Attorney has not placed into the record sufficient references to establish that "magnesite" or "magnesia" is highly descriptive of the refractory products in Class 19 or information services in Class 37. The Examining Attorney only points to web page excerpts that show magnesia or magnesite can be a component of refractory products.

Applicant, however, does not observe any evidence that the present mark "MAGNESITA," immediately tells prospective customers about a feature of Applicant's "refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes," and "providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations."

That is, while the term "magnesite" may be merely descriptive, the record does not establish that the mark MAGNESITA is highly descriptive of refractory products and information services.

Applicant submits, similar to the Board's holding in *In re Greek Gourmet Inc.* (where the Board held that if the "mark "GREEK GOURMET" was highly descriptive, if not generic, as contended by the Examining Attorney, then it is hard to understand how there were fewer than 70 references to this term

during a time span of nearly 30 years”), in the present appeal this Board should find that since the Examining Attorney has not provided any evidence that the mark “MAGNESITA” has been used in connection with describing refractory products or information services, the record dictates the only conclusion, that the mark “MAGNESITA” is not highly descriptive of the recited refractory products or information services.

Applicant submits that the Examining Attorney has only provided evidence that magnesia or magnesite can be used in refractory products. Applicant, however, does not observe any evidence that the mark “MAGNESITA” is used to describe any specific type of refractory product or information service. In fact, as evidenced by the declaration filed May 6, 2015, Applicant has not found any instance where the mark “MAGNESITA” was used to describe the refractory product, but rather, only observed the generic terms “castable refractories,” “precast refractory shapes,” “mortar,” “castable,” “fire brick,” and “refractory brick” as being used to describe the refractory products and information services. In other words, Applicant submits that since the Examining Attorney has not provided any evidence that the terms magnesia, and magnesite, let alone the mark “MAGNESITA” have been used to describe refractory products and information services, the mark “MAGNESITA” cannot be highly descriptive of the recited products or services.

**2. THE MARK HAS ACQUIRED DISTINCTIVENESS BECAUSE OF MORE
THAN FIVE YEARS OF SUBSTANTIALLY EXCLUSIVE AND
CONTINUOUS USE.**

The amount and character of evidence to establish acquired distinctiveness depends on the facts of each case, and becomes progressively greater as the descriptiveness of the term increases. *In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694 * 3 (TTAB 2002) (non-precedential); *In re the Kyjen Company, Inc.*, 2012 WL 1424429 * 6 (TTAB 2012) (non-precedential); *In re Whitetail Inst. Of North America, Inc.*, 2014 WL 1390517 * 2 (TTAB 2014) (non-precedential). Since the mark “MAGNESITA” is not highly descriptive of Applicant’s goods and services, the Director should accept as prima facie evidence that the

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mark has become distinctive with proof of substantially exclusive and continuous use for more than five years.

The Examining Attorney has erred by not fully considering Applicant's claim of acquired distinctiveness based. Applicant submits that the mark "MAGNESITA" is at most merely descriptive and not highly descriptive of Applicant's "refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes," and "providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations."

The Examiner should have accepted the declarations filed September 23, 2014 and May 6, 2015 as prima facie evidence that the mark has acquired distinctiveness based on the more than five years of exclusive and continuous use of the mark "MAGNESITA." The Declaration of Gross Sales establishes that the mark MAGNESITA has been used in association with the sale of refractory products in excess of US \$103,000,000 in 2010, in excess of US \$200,000,000 in 2011, in excess of US \$200,000,000 in 2012, in excess of US \$230,000,000 in 2013, and in excess of \$220,000,000 in 2014. Applicant has exclusively used the mark "MAGNESITA" in commerce since 2008. That is, Applicant has sold more than almost 1 billion dollars of refractory products during this period under the mark MAGNESITA, which clearly establishes that the mark MAGNESITA indicates that Applicant is the source of the goods and services.

V. SUMMARY

The application should be approved for registration on the Principal Register because the mark "MAGNESITA" is not generic and has acquired distinctiveness. Applicant respectfully requests that this Board reverse the refusal of registration.

Respectfully submitted,

/Thomas J. Moore/

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